

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

MARCH 31, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Platinum Technology, Inc.**

Serial No. 75/051,527

Martin R. Greenstein for Platinum Technology, Inc.

Kathleen M. Vanston, Trademark Examining Attorney, Law
Office **103** (Michael A. Szoke, Managing Attorney).

Before **Cissel**, Hohein and Hairston, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On January 31, 1996, applicant filed the above-
referenced application to register the mark "C/S-TEST" on
the Principal Register for "computer software for use in
the field of database design and administration,
programming, system administration and application software
development, testing and debugging in standalone,
distributed networking and client/server environments, and
instructional manuals sold as a unit therewith," in Class

9. The application was based on applicant's assertion that it possessed a bona fide intention to use the mark in commerce.

The Examining Attorney refused registration under Section 2(e)(1) of the Act on the ground that applicant's mark is merely descriptive of the goods specified in the application because it describes the function of the product, which is software for use in application software testing in the client/server, or "C/S," environment.

Attached to the Office Action in which the refusal to register was made were copies of excerpts from published articles retrieved from the Nexis® database which show that the abbreviation "C/S" is used interchangeably with "client/server" in reference to the client server computer environment. Examples include the following:

"Client/server (C/S) computing can indeed be a formidable challenge..." and "...applications are implemented across distributed Client/Server (C/S) configurations, business applications and systems..."

Applicant responded to the refusal to register with argument that its proposed mark is not merely descriptive, but rather only suggestive. Applicant contended that the Office has allowed other marks of third parties where "C/S" is the first term in a two-term mark, as well as marks

wherein the word "TEST" is combined with other "arguably descriptive" words.

The Examining Attorney was not persuaded, and she made the refusal to register final in her second Office Action. Attached to that action was a copy of a definition of the word "test" from the IBM Dictionary of Computing (10th ed.) as "the operation of a functional unit and comparison of its achieved result with the defined result to establish acceptability."

On May 30, 1997, applicant filed an amendment to allege use of the mark on the specified goods in interstate commerce since February 7, 1996.

Applicant timely filed a Notice of Appeal on September 15, 1997. Both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing before the Board.

A mark is merely descriptive of the goods on which it is used if it immediately and forthwith conveys information about the product's character, function, features or purpose. In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). It is not necessary that a term describe all of the purposes, functions, characteristics or features of the goods in order for it to be merely descriptive of them. In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982).

The mark sought to be registered in the instant case, "C/S-TEST," is merely descriptive of software for use in testing in the client/server environment because the mark identifies the function or purpose of the software, i.e., to test application software in the client server environment. The materials made of record by the Examining Attorney make it clear what "C/S" and "TEST" mean, and the fact that the two terms are joined by a hyphen does not alter their connotation.

Applicant argues that reaching this conclusion about the goods from consideration of the mark cannot be accomplished without taking "mental steps" or engaging in "extensive mental gymnastics." We agree with the Examining Attorney that this is just not the case. A prospective purchaser of applicant's computer programs who knows that their function or purpose is "application software development, testing and debugging in standalone, distributed networking and client/server environments," as the identification-of-goods clause puts it, will immediately and forthwith understand from the mark that the programs are used to test application software in the C/S environment.

Applicant argues that third-party registrations of other marks for different goods support the proposition

that the mark in the instant application is not descriptive of the goods named in this application. It is well settled, however, that each case must be decided on its own merits, based on the record in each particular application. As the Examining Attorney points out, a mark which is merely descriptive is not somehow registrable simply because other similar marks are registered. In re Scholastic Testing Services, Inc., 196 USPQ 517 (TTAB 1977). It is true that third-party registrations, when they are properly of record, can be useful in establishing the meanings of terms used in them, but applicant did not make of record any of the registrations it argues support the registration of its mark. The Board does not take judicial notice of registrations. In re Duofold Inc., 184 USPQ 638 (TTAB 1974).

When the mark in the instant application is considered in conjunction with the goods identified therein, it is clear that the mark conveys specific information about the

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function or purpose of the goods. Accordingly, the refusal to register under Section 2(e)(1) of the Act is affirmed.

R. F. Cissel

G. D. Hohein

P. T. Hairston
Administrative Trademark Judges
Trademark Trial and Appeal Board

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